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PATENT APPLICATION
Docket No. 15436.176.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
)
Timothy E. Bean et al.)
)
Serial No.:	10/702,408) Art Unit
) 2188
Filed:	November 6, 2003)
)
For:	SELECTING AND MANAGING TIME)
	SPECIFIED SEGMENTS FROM A LARGE)
	CONTINUOUS CAPTURE OF NETWORK)
	DATA)
)
Confirmation No.:	8343)
)
Customer No.:	022913)
)
Examiner:	Michael B. McFadden)
)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed 14 May, 2007 (the "Final Office Action"), Applicants respectfully request a panel review of the final rejection under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal.

REMARKS

In the Final Office Action, the Examiner rejected claims 1-6, 9-11, and 13-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,965,574 to *Cook et al.* ("Cook") in view of U.S. Patent No. 6,356,256 to *Leftwich* ("Leftwich"); rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Cook* and *Leftwich* in view of U.S. Patent No. 6,580,959 to *Mazumder* (*Mazumder*). Finally, the Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Cook* and *Leftwich* in view of U.S. Patent No. 6,577,323 to *Jamieson et al.* (*Jamieson*).

Withdrawal of the rejection of claims 1-30 is respectfully requested for at least the reasons set forth herein and in Applicants' papers filed 10 July 2006 and 21 February 2007.

I. Lack of Substantial Evidence to Support the Rejections – Clear Legal Error

The standard of review applied to the Examiner's findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). *See In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000). According to the MPEP, "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support." *MPEP* § 2144.03 (citing *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001)). *See also In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002) ("The [Office] cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.") The MPEP also states that "[c]onclusory statements of similarity...without any articulated rationale or evidentiary support, do not constitute sufficient factual findings." *MPEP* § 2144.08.III.

Applicants note at the outset that the rejections, stated in the Final Office Action, of independent claims 1, 19, and 23 are little more than verbatim restatements of the rejections of those claims set forth in the Office Action mailed March 10, 2006, and in the Office Action mailed September 21, 2006. As well, the Examiner has largely failed to address the deficiencies identified in Applicants' papers filed 10 July 2006 and 21 February 2007.

For example, in a purported response to Applicants' repeated contentions that the Examiner has completely failed to identify, with any specificity whatsoever, which elements of *Cook* are believed to correspond with the elements and processes recited in claim 1 (*See, e.g.*, Applicants' Paper filed 10 July 2006 at 12-15, and Applicants' Paper filed 21 February 2007 at 10-13), the Examiner simply replied that "it is apparent to one of ordinary skill in the art that one of ordinary skill in the art would know which elements of a given figure would fulfill the claimed limitations."¹ *Final Office Action* at 10 (emphasis added). This reply is wholly inadequate to establish a lack of patentability of the claims however.

In particular, Applicants note at the outset that the aforementioned reply by the Examiner is circular, inasmuch as the Examiner has based the rejection on nothing more than what is essentially an assertion that "...one of skill in the art would know what one of skill in the art would know." Moreover, the Examiner's own words belie the assertion that the Examiner is not relying on personal knowledge. Specifically, the Examiner has simply asserted, without elaboration, explanation, rationale, or citation to the references or any other source that "...it is apparent to one of ordinary skill in the art...which elements

¹ The Examiner's analysis of *Cook* as applied to claim 1 is as follows: "Cook: Figure 3 shows the organization of network traffic. The number of packets, number of bytes, flow start and end time are all present in the network traffic information. Knowing the flow start time and end time gives you the total clock ticks of the capture." *See Final Office Action* at 4 and 13. Notwithstanding these assertions, the Examiner has completely failed to identify, with any

of a given figure would fulfill the claimed limitations.” Inasmuch as the Examiner has not referred to any other source in the aforementioned rejection, it is clear that the only possible knowledge upon which the Examiner could be relying is the Examiner’s own personal knowledge, namely, the personal knowledge and belief of the Examiner as to what one of ordinary skill in the art would purportedly know.

Even if it were argued that the Examiner has not relied on personal knowledge, it is nonetheless clear that the aforementioned rejection by the Examiner is nothing more than a conclusory statement as to what one of ordinary skill in the art would purportedly glean from the references. Applicants submit, however, that mere conclusions, without more, simply do not provide adequate evidentiary support to sustain a claim rejection. (*See, e.g., MPEP § 2144.08.III* reflecting the general notion that mere conclusions by the Examiner are inadequate to support a rejection).

As indicated by the foregoing examples, there is a distinct lack of evidentiary support in the record for the rejections advanced by the Examiner. This lack of substantial evidentiary support is perhaps best exemplified in the response of the Examiner to Applicants’ repeated, and unfulfilled, requests for personal knowledge affidavits (*See, e.g., Applicants’ Paper filed 10 July 2006 at 12-15, and Applicants’ Paper filed 21 February 2007 at 10-13*): “[T]he Examiner is not relying upon personal knowledge. It would be apparent to one of ordinary skill in the art and one of ordinary skill in the art would know the aforementioned information.” *Final Office Action* at 11. Nonetheless, the Examiner has failed to indicate how the Examiner can be so certain as to what one of skill in the art would purportedly “know.”

In light of the preceding discussion, Applicants submit that it is clear that the rejection of independent claim 1 is based on nothing more than conclusory and self-serving statements by the Examiner as to what a person of ordinary skill in the art would purportedly glean from the cited references. Thus, the rejection is not “based on any evidence in the record,” and therefore, according to the MPEP, “lacks substantial evidence support.” (*See MPEP § 2144.03*.) Applicant submits that inasmuch as the rejection lacks substantial evidentiary support in the record, the rejection of claim 1 and its corresponding dependent claims is not well taken and should be withdrawn. In the context of 35 USC §103(a), Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the rejected claims at least because there is a lack of substantial evidence on the record to support a finding that the references, when combined or modified in the purportedly obvious fashion, teach or suggest all of the limitations of the rejected claims.

Applicants note that the foregoing legal error considerations are germane as well to the rejections of independent claims 19 and 23, inasmuch as each of those claims has been rejected solely based on a “rationale” purported by the Examiner to be similar to that expressed in connection with the rejection of

specificity whatsoever, which elements of *Cook* are believed to correspond with the elements and processes of claim 1. Moreover, the Examiner has failed to cite any portion of *Cook* in support of this characterization of Figure 3.

claim 1. (*See Final Office Action* at 6). Applicants accordingly submit that inasmuch as the rejection of claims 19 and 23, and their respective dependent claims, lacks substantial evidentiary support in the record, the rejection of claims 19 and 23, as well as the rejection of their respective dependent claims, is not well taken and should be withdrawn.

II. Examiner Has Not Applied the Proper Standard

The Examiner has asserted several times in the claim rejections that “...it is apparent to one of ordinary skill in the art...which elements of a given figure would fulfill the claimed limitations” (emphasis added). (*See, e.g.,* paragraphs 39, 40, 45, 46, 50, and 53 of the Final Office Action). However, the Examiner must make the disclosure of such features apparent to the Applicant, irrespective of whether or not such features would be apparent to a hypothetical person of ordinary skill in the art. The examination guidelines confirm this, stating that “In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR 1.104 (emphasis added). Moreover, “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP § 706 (emphasis added). By applying the incorrect standard, the Examiner has in effect compelled Applicants to guess at what the Examiner believes to be the correspondence between the cited references and the claim limitations, the Examiner has not discharged the burden imposed by the aforementioned examination guidelines. Insofar as the Examiner has failed to conduct the examination of the claims in accordance with the established guidelines, the rejections of claims 1-6, 9-11, 13-19, and 23, at least, are not well taken and should accordingly be withdrawn.

III. The Examiner Has Failed to Consider Each Limitation of Every Claim

Applicants respectfully note that on numerous occasions, the Examiner has simply failed to consider the actual language recited in the claims. (*See, e.g.,* Applicants’ Paper filed 21 February 2007 at 12 and 13, noting the failure of the Examiner to address various limitations of claims 2, 5, 6, 8, 10, 11, 16-23, and 24-29). In one example of the Examiner’s response to Applicant’s argument on this point, the Examiner has asserted with respect to claim 2, for example, that the Examiner has “considered all of the limitations of claim 2, and has determined that the further limitation of graphing byte density over time is rejected using the same rationale as the network traffic limitation of claim 1.” *Final Office Action* at 10. However, the Examiner has consistently failed to explain the rationale underlying this determination. Moreover, there is no evidence on the record, beyond the bare assertion of the Examiner, that each of the limitations of claims 2, 5, 6, 8, 10, 11, 16-23, and 24-29 have, in fact, been addressed. Recently added

claim 30 has been afforded a treatment similar to that of the aforementioned claims. (*See Final Office Action at 7*).

IV. The Examiner Has Failed to Establish Elements of *prima facie* Obviousness

Insofar as the Examiner has failed, as noted at I. through III. above, to establish that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claims 1-30 (See also, Applicants' Paper filed 10 July 2006 at 11-17, and Applicants' Paper filed 21 February 2007 at 10-15), the Examiner also has failed to specifically identify what the Examiner believes to constitute the purportedly obvious combinations. Consequently, the Examiner has also necessarily failed to establish that there is a reasonable expectation that the purportedly obvious combinations, as yet unspecified, would prove successful in implementation. Finally, the Examiner has consistently failed to articulate, much less establish the existence of, a motivation to combine references so as to arrive at the inventions to which claims 19 and 23, for example, are respectively directed. *See, e.g.*, Applicants' Paper filed 10 July 2006 at 15. *See also Final Office Action at 4-7* (no motivation articulated for claims 2-6, 9-11, and 13-30).

CONCLUSION

In view of the discussion submitted herein, Applicants respectfully submit that each of the pending claims 1-30 is in allowable form. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 2nd day of November 2007.

Respectfully submitted,

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